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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JACKSON, JENISE E

ART UNIT

PAPER NUMBER

2439

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/699,703	<b>Applicant(s)</b> MURASHITA ET AL.	
	<b>Examiner</b> JENISE E. JACKSON	<b>Art Unit</b> 2439	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-11, 14-22, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 6-11 and 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/26/09 has been entered.

### ***Drawings***

2. Figures 8 and 13 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 6-11, 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ebara(2002/0010862).

5. As per claim 6, Ebara discloses a terminal device includes a biometric data acquisition unit(i.e. registration apparatus #4 fig. 1 sheet 1)which acquires biometric data from a user[0008, 0024-0025]; a biometric data storing unit(i.e. database server) which stores first biometric data whose kind corresponds to the biometric data acquisition unit[0010] and second biometric data whose kind is not obtainable by the biometric data acquisition unit[0012], the first biometric data and the second biometric data(i.e. iris data) both being associated with the user, an authentication unit(i.e. first authentication apparatus 5 see fig. 1 sheet 1) which authenticates the user based on the acquired biometric data and the first biometric data; and a biometric data output unit which outputs the second biometric data from the biometric data storing unit, after the user has been authenticated by the authentication unit[0035-0038].

6. As per claim 7, Ebara discloses a biometric data processing unit which edits and processes at least partially said second biometric data, wherein said edited and processed second biometric data is output[0038].

7. As per claim 8, Ebara discloses a biometric data converting unit which converts the format of said second biometric data, wherein format-converted second biometric data is output[0038].

8. As per claim 9, Ebara discloses a corresponding data generating unit which, from said second biometric data selected from said biometric data storing unit, generates corresponding data having a certain bit length and corresponding to said second biometric data, wherein said generated corresponding data is output from said second biometric data output unit[0029, 0038].

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9. As per claim 10, Ebara discloses a corresponding data parameter generating unit which generates a parameter to be used for generating the corresponding data[0029, 0038].

10. As per claim 11, Ebara discloses a terminal device, a biometric data acquisition unit(i.e. registration apparatus #4 fig. 1 sheet 1) which acquires biometric data from a user[0008, 0024-0025]; a biometric data storing unit(i.e. database server) which stores first biometric data whose kind corresponds to the biometric data acquisition unit[0010], and second biometric data whose kind is not obtainable by the biometric data acquisition unit[0012], the first biometric data and the second biometric data both being associated with the user, an authentication unit(i.e. first authentication apparatus #5 see fig. 1 sheet 1) which authenticates the user based on the acquired biometric data and the first biometric data, and a biometric data output unit which outputs the second biometric data from the biometric data storing unit, after the user has been authenticated by the authentication unit[0035-0038]; an authentication device having a dictionary data storing unit which stores biometric data as dictionary data to be used for authentication[0042]; and a first authentication unit which performs first person authentication based on comparing said second biometric data transmitted from the biometric data transmitting unit, and said dictionary data stored in the dictionary data storing unit[0036-0038].

11. As per claim 14, Ebara discloses wherein the first authentication device comprises a corresponding data generating unit which, based on said biometric data transmitted from said biometric data transmitting unit, generates corresponding data having a certain bit length and corresponding to the second biometric data[0029, 0038], wherein specific dictionary data stored in said dictionary data storing unit is located by using said generated corresponding data, and said first person authentication unit performs said person authentication based on said specific

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dictionary data and said transmitted biometric data[0036-0038, 0042].

12. As per claim 15, Ebara discloses wherein when said first person authentication based on said specific dictionary data cannot be performed, said first authentication device performs said first person authentication based on all of said dictionary data stored in said dictionary data storing unit and said transmitted second biometric data[0046-0047].

13. As per claim 16, Ebara discloses wherein said terminal device includes a first biometric data processing unit which edits and processes at least partially said second biometric data selected from said biometric data storing unit[0029, 0038], and a first processing data storing unit which stores data that said first biometric data processing unit uses to edit and process said second biometric data, and said authentication device includes a second biometric data processing unit which edits and processes said dictionary data at least partially, and a second processing data storing unit which stores data that said second biometric data processing unit uses to edit and process said dictionary data, and wherein said first person authentication unit performs said person authentication based on said edited and processed biometric data and said edited and processed dictionary data[0036-0038, 0042].

14. As per claim 17, Ebara discloses wherein said authentication device comprises a conversion data storing unit which stores conversion data concerning said biometric data used in said first person authentication unit, and said terminal device comprises a second biometric data converting unit which converts the format of said second biometric data stored in said second biometric data storing unit, and wherein said biometric data converting unit converts the format of said biometric data by using said format data transmitted from said conversion data storing unit, and said format-converted second biometric data is transmitted to said authentication

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device[0036-0038].

15. As per claim 18, Ebara discloses a first corresponding data generating unit which generates first corresponding data having a certain bit length and corresponding to specific second biometric data[0029, 0038], and a corresponding data transmitting unit which transmits out said generated first corresponding data; the authentication device, a second corresponding data generating unit which generates corresponding data having a certain bit length and corresponding to said dictionary data wherein, the first person authentication unit which performs first person authentication based on said transmitted first corresponding data and said second corresponding data[0036-0038, 0042].

16. As per claim 19, Ebara discloses wherein said terminal device includes a biometric data acquisition unit(i.e. registration apparatus #4 fig. 1 sheet 1) which acquires biometric data[0008, 0024-0025] and a second person authentication unit which performs second person authentication, and wherein said second person authentication is performed using said acquired biometric data and said biometric data stored in said biometric data storing unit and, when the identity of said person has been authenticated, said first corresponding data to be used in said first person authentication unit is transmitted to said authentication device[0038].

17. As per claim 20, Ebara discloses wherein said terminal device includes a first corresponding data parameter generating unit which generates a corresponding data parameter to be used for generating said corresponding data, and wherein said generated corresponding data parameter is not only used in said first corresponding data generating unit, but also transmitted to said authentication device and used in said second corresponding data generating unit[0029, 0038].

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18. As per claim 21, Ebara discloses wherein said authentication device includes a second corresponding data parameter generating unit which generates a corresponding data parameter to be used for generating said corresponding data, and wherein said generated corresponding data parameter is not only used in said second corresponding data generating unit, but also transmitted to said terminal device and used in said first corresponding data generating unit[0029, 0047].

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ebara(2002/0010862) in view of Uchida(2001/0025342).

21. As per claim 22, Ebara does not disclose wherein said authentication device encrypts data that said person has by using said corresponding data used for the authentication of said person as an encryption key. Uchida discloses wherein the authentication device encrypts data that the person has by using the corresponding data used for authentication of the person as an encryption key[0022, 0028]. It would have been obvious of one of ordinary skill in the art at the time of the invention to include biometric data is encrypted biometric data of Uchida with Ebara, because encrypting biometric data is a protective measure that can enhance security, because even if an



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unauthorized person steals the biometric data in transit, because the biometric data is encoded[0067 of Uchida] it is intelligible.

***Allowable Subject Matter***

22. Claims 27-28 are allowable for the following features, “the decryption key is used by the authentication device, the biometric data acquisition device charges a fee to the authentication device for the use”, and “charging a fee to the authentication device according to the number of times that the biometric data stored into the terminal device by the biometric data acquisition device is used by the authentication device”. Prior art of record fails to disclose charging a fee for a decryption key, and charging a fee according to the number of times that the biometric data is stored. In prior art, if a user is enrolled in the system, a user is given a decryption key, there is no suggestion or disclosure of a charge to use a decryption key, and no suggestion in prior art as to how many times biometric data is stored. The Applicant is urged to incorporate allowable subject matter as stated in claims 27-28, in independent claims 6 and 11. The Applicant contacted Attorney of record, to do an Examiner’s Amendment to incorporate claims 27-28 into independent claims 6, and 11. In order to reduce prosecution, the Applicant is urged to amend claims 6 and 11, by incorporating claim limitations of claims 27-28 into claims 6 and 11, or by canceling claims 6 and 11, since claims 27-28 are allowable.

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**Response to Applicant**

23. A Final office action was mailed on 2/23/09 which claims 6-11 and 14-22 were rejected. Claims 27-28 were previously allowed. The Applicant has filed a response on 5/26/09 with a request for reconsideration. Claims 6-11, 14-22, and 27-28 are pending.

24. Applicant's arguments filed 5/26/09 have been fully considered but they are not persuasive.

25. First, the Examiner has not relied on Ortiz to meet the claim limitations above. Thus, any remarks in regards to Ortiz are moot. Second, the Applicant states that Ebara discloses the same kind of biometric authentication data. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., first biometric data and second biometric data which are different) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If the Applicant wishes the Applicant should amend the claims to show that the first biometric data is different from the second biometric data.

26. The Applicant states that Ebara does not disclose that an authentication unit authenticates based on first biometric data acquired by a biometric data acquisition unit, and the biometric data output unit outputs second biometric data which is not attainable by the biometric data acquisition unit, after the user has been authenticated. The Examiner disagrees with the Applicant. Ebara discloses an authentication unit authenticates based on first biometric data acquired by a biometric data acquisition unit, because Ebara discloses the first authentication

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apparatus acquires a user's biometric information from the registration apparatus[0024-0025], and the biometric data output unit outputs second biometric data which is not attainable by the biometric data acquisition unit, after the user has been authenticated, because Ebara discloses during authentication, the first database server receives authentication data from the first authentication apparatus and authenticates the user by comparing the authentication data with the stored template data[0026]. Ebara discloses the second biometric data is not attainable by the biometric data acquisition unit, because Ebara discloses the second enterprise system can register users simply by acquiring their template data from the first enterprise system, without having to provide or operate a registration apparatus [0012]. In order to reduce prosecution, the Applicant is urged to amend the claims to one biometric acquisition unit is used for the first and second biometric data where the first and second biometric data are different.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENISE E. JACKSON whose telephone number is (571)272-3791. The examiner can normally be reached on Increased Flex time, but generally in the office M-Fri(8-4:30)..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 29, 2009

/J. E. J./

Examiner, Art Unit 2439

/Michael J Simitoski/

Primary Examiner, Art Unit 2439